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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,809	07/25/2003	Frank Lesniak	034266	2534
28143	7590	11/01/2005	EXAMINER	
NATTER & NATTER			ALI, SHUMAYA B	
501 FIFTH AVENUE				
SUITE 808				
NEW YORK, NY 10017			ART UNIT PAPER NUMBER	
			3743	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/626,809	LESNIAK ET AL.
	Examiner Shumaya B. Ali	Art Unit 3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 July 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: detailed action.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-17 drawn to interocclusal sports prophylaxis, classified in class 128, subclass 861.
  - II. Claim 18-20, drawn to a method of fabricating an interocclusal sports prophylaxis. classified in class 128. subclass 861

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case steps of method claim 18 can be performed with a materially different apparatus.
3. During a telephone conversation with **Howard Natter**, on **10/14/05** a provisional election was made **with** traverse to prosecute the invention of Group I claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 recites the limitation "the selected zones" in line 5 on page 22. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Farrell US Patent No. 6,935,857 B1**  
Farrell in figures 1-5 discloses an oral appliance, a mouth guard or an orthodontic device, therefore capable of being used as an oral prophylaxis (protective treatment for teeth) comprising:

- An arched shaped occlusal plate (1)
- Maxillary buccal (97) and lingual (6) walls
- A dentition encasement material (3,4)
- A generally planar lower mandibular face (11)

- A labial force dispersal shield (17)
- The mandibular face having a pair of molar zones in registration with mandibular molar teeth (molar areas are inherently located at the distal portion of 11 or proximal to 5 in fig.5)
- The dentition encasement material covers the molar zones and an incisor zones of the mandibular face (col.1 lines 55-65 and col.2 lines 1-30), the incisor zone being registered with the labial force dispersal shield (see fig.3)

**9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell US Patent No. 6,935,857 B1 in view of Orrico US Patent No. 6,170,485 B1**

Farrell in figures 1-5 discloses an oral appliance, a mouth guard or an orthodontic device, therefore capable of being used as an oral prophylaxis (protective treatment for teeth) which recites all limitations cited in claims 1-14 except for: selected zones being spaced from one another along the mandibular face, mandibular occlusal surfaces not registered with the selected zones being spaced from the mandibular face, the mandibular face is generally planar except at the selected zones, the occlusal plate extends below the plane of the mandibular face a distance in the order of at least one mm at eh selected zones. However, at the time of the invention limitation not taught by Farrell were well known in the art. Orrico teaches in figure1, an oral appliance also capable of being used as an oral prophylaxis (protective treatment for snoring) with a mandibular occlusal surface (22), selected zones (38) being spaced from the mandibular face, where the mandibular face is generally planar except at the selected zones and occlusal plate extends below the plane of the mandibular face a distance in the order of at least one mm at the selected zones. Orrico additionally teaches the structure 38 provides a breathing opening (col.4 lines 65-67). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to include spaced selected zones to the oral appliance of Farrell

in view of Orrico for the purposes preventing airway obstruction by ensuring breathing through the spaced selected zones when the appliance is in use.

Regarding limitation cited in claims 10-14, applicant claimed measurement(s) or percentage(s), however the applicant has not established why those measurement(s) or percentage(s) are critical to the invention. Therefore, it would have been obvious to one of ordinary skills in the art to consider those limitations as obvious design choices and additionally consider Farrell's disclosure to be obvious to overcome the limitations cited in claims 10-14.

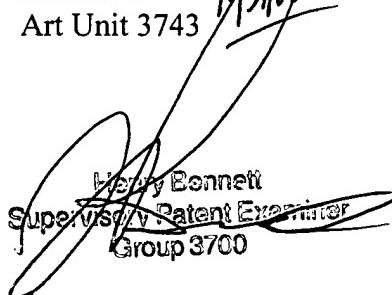
As to claim 17, Farrell discloses all limitations and that applied in claims 15-16 except for: mandibular occlusal surfaces not registered with the zones being spaced from the mandibular face. However, at the time of the invention limitation not taught by Farrell were well known in the art. Orrico teaches in figure1, an oral appliance also capable of being used as an oral prophylaxis (protective treatment for snoring) with a mandibular occlusal surface (22), selected zones (38) being spaced from the mandibular face, where the mandibular face is generally planar except at the selected zones and occlusal plate extends below the plane of the mandibular face a distance in the order of at least one mm at the selected zones. Orrico additionally teaches the structure 38 provides a breathing opening (col.4 lines 65-67). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to include spaced selected zones to the oral appliance of Farrell in view of Orrico for the purposes preventing airway obstruction by ensuring breathing through the spaced selected zones when the appliance is in use.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shumaya B. Ali  
Examiner  
Art Unit 3743  
  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700